

REMARKS

The Examiner is respectfully requested to enter the foregoing amendment prior to examination of the above-identified patent application, and consider the following remarks.

By this Amendment, claims 3, 15, 16 and 26 have been amended. No new matter has been added. Support for the amendments to the claims can be found on at least page 5, lines 14-17, page 10, lines 17-19 and Fig. 7 of the specification as originally filed. Claims 1-5, 7, and 9-27 are pending and respectfully submitted for consideration.

Claims 1, 2, 4, 5, 7 and 9-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Furuta et al. (U.S. Patent Publication No. US 2003/0094761 A1, "Furuta") in view of Goldman (U.S. Patent No. 5,997,002) and Guidi (U.S. Patent No. 5,839,732). Claims 2, 4, 5, 7, and 9-14 depend either directly or indirectly from claim 1. Furuta was cited for disclosing many of the claimed elements of the invention with the exception of awarding a bonus prize to the one of the at least one player participating in the auxiliary play dealt four royal cards of the same suit; taking a first ante from each of the at least one player selecting not to wager in the first round; and for each of the at least one player that folds, taking the at least one player out of the game. Goldman and Guidi were cited for curing these deficiencies.

Claims 3 and 15-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Furuta in view of Guidi. With respect to claims 3 and 15, Furuta was cited for disclosing many of the claimed elements of the invention with the exception of the card games being played in accordance with the standard rules of poker using

hands of five cards. Guidi was cited for curing this deficiency. With respect to claims 16 and 26, the Office Action further took the position that it is obvious to play a card game in a system comprising at least one input device, a processor, and at least one display device coupled to the processor.

To the extent that the above-noted rejections remain applicable to the claims currently pending, the Applicant respectfully submits that claims 1-5, 7, and 9-27, as amended, recite subject matter that is neither disclosed nor suggested by Furuta, Goldman and Guidi either singly or in combination.

Claim 1, as amended, recites awarding a bonus prize to the one of the at least one player participating in the auxiliary play dealt four royal cards of the same suit, regardless of the dealer hand. In contrast, Furuta discloses a game “played on a gaming table, with a regular standard deck of cards consisting of 52 cards, and with between one and seven players and a dealer. A hand is dealt for each player and the dealer. Each player is allowed an opportunity to place a bonus bet based on the hand. The hand is then formed into a high hand and a low hand, and a play bet is placed on these two hands. The player's high and low hands are compared to the dealer's high and low hands, respectively, and winners are paid according to a payout schedule.” (Emphasis added). See the Abstract of Furuta. As such, Furuta does not disclose or suggest that the player with four royal cards of the same suit is awarded a bonus prize regardless of the dealer hand, as recited in amended claim 1.

As noted above, the Office Action acknowledged that Furuta does not disclose taking further antes if the player selects not to wager in the first round, and taking the player out of the game when the player folds, as recited in claim 1. The Office Action

took the position that “Goldman discloses taking further antes if the player decides to fold *col. 4, lines 9-10)”. See page 3, lines 10-11 of the Office Action. In contrast, Goldman discloses that “if a player looks at his cards and decides he has a poor or unfavorable hand, he may fold or forfeit his ante wager. The ante wager preferably includes the side bets at this point.” See column 4, lines 7-10 of Goldman. The Applicant submits that there is no disclosure or suggestion in Goldman of at least the feature of taking further antes if the player selects not to wager in the first round. As such, Goldman fails to cure the deficiencies in Furuta, with respect to amended claim 1.

Also, with respect to amended claim 1, the Office Action cited Guidi for disclosing “taking the player out of the game when the player folds (col. 6, lines 3-5).” In contrast, Guidi discloses that:

[b]ased on the perceived strength of the hand, each of the players decides whether to fold or stay, as represented in decision block 63. If a player decides to fold, he is out of the game, as represented by block 64, and he forfeits his ante which is placed in the winner’s pot 25 (Fig. 1) to be combined with the remaining bets before distributing the winnings.

See column 6, lines 1-7 of Guidi.

The Applicant submits that Guidi fails to cure the deficiencies in Furuta and Goldman with respect to claim 1. Specifically, Guidi fails to disclose or suggest at least the combination of features of awarding a bonus prize to the one of the at least one player participating in the auxiliary play dealt four royal cards of the same suit, regardless of the dealer hand, and taking a second ante from each of the at least one player participating in the auxiliary play and selecting not to wager in the first round, as recited in claim 1. As such, Furuta, Goldman and Guidi, either singly or in combination, fail to disclose or suggest the claimed features of the invention. For at least the

combination of foregoing reasons, the Applicant submits that amended claim 1 is allowable over the cited art.

With respect to amended claims 3, 15, 16 and 26, the Applicant submits that Furuta and Guidi fail to disclose or suggest the claimed features of the invention. Claim 3, as amended, recites awarding a bonus prize to the one of the at least one player participating in the auxiliary play dealt four royal cards of the same suit regardless of the dealer hand. Claim 15, as amended, recites awarding a bonus prize to the one of the at least one player participating in the auxiliary play assigned with the representation of cards corresponding to four royal cards of the same suit, regardless of a qualifying hand. Claims 16 and 26, as amended, recite that the processor awards a bonus prize to the one of the at least one player participating in the auxiliary play assigned the representations of cards corresponding to the four royal cards of the same suit regardless of a qualifying hand. In contrast, Furuta discloses that "in order for the player to win, the player must beat both hands of the dealer." See paragraph [0034] of Furuta. Guidi discloses that the hands of the dealer and the players are then examined in order to determine the holder of the hand having highest poker rank among the players and the dealers. See column 4, lines 8-10 of Guidi. Therefore, the Applicant submits that Furuta and Guidi either singly or in combination fail to disclose or suggest at least the claimed combination of features set forth above, as recited in claims 3, 15, 16 and 26.

Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where

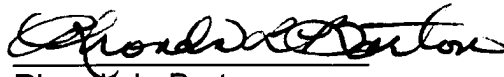
a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in the applied references to evidence the desirability of these advantages in the disclosed structure.

In view of the above, the Applicant respectfully submits that Furuta, Goldman and Guidi do not support a *prima facie* case of obviousness for purpose of a rejection of claims 1, 3, 15, 16, and 26, and the claims dependent therefrom, under 35 U.S.C. § 103. Accordingly, the Applicant respectfully requests withdrawal of the rejections, allowance of claims 1-5, 7, and 9-27 and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 026066-00006.**

Respectfully submitted,



Rhonda L. Barton
Attorney for Applicant
Registration No. 47,271

Customer No. 004372
ARENT FOX PLLC
1050 Connecticut Avenue, N.W., Suite 400
Washington, D.C. 20036-5339
Tel: (202) 857-6000
Fax: (202) 638-4810

RLB/vdb/wbp

Enclosures: RCE Transmittal
Petition for Extension of Time (Three Months)